

## 05 Notable Bad Faith Trademark Cases in Vietnam:

### What Lessons Should You Learn?

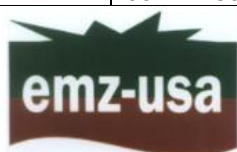
Trademark squatting or the bad faith registration of trademarks to misappropriate the intellectual property of foreign companies for illicit profit has become increasingly common in Vietnam. The more prestigious and reputable the brand, the greater the risk of becoming a target of this exploitative practice.

KENFOX IP & Law Office would like to provide 05 notable [bad faith trademark cases in Vietnam](#) so that IPR holders who are currently conducting or planning to conduct business in Vietnam can understand the potential risks and challenges, having clearer picture of the legal processes in Vietnam, based on which better strategize their trademark filing, understand the legal remedies available, recognize typical timelines, and identify the evidence required to challenge bad faith registrations in Vietnam.

#### Case 1: Château Latour v. CHATEAU LATOUR

[Executive summary]: Intrixapple Co., Ltd., a Vietnamese company, applied to register the mark “CHATEAU LATOUR” for the goods in Class 33 (wine). SOCIÉTÉ CIVILE DU VIGNOBLE DE CHÂTEAU-LATOUR (France) is an entity associated with the renowned **Château Latour** in Bordeaux, France. Upon detecting a third party in Vietnam applied to register the mark “CHATEAU LATOUR”, it filed a Notice of Opposition, requesting the IP Office of Vietnam (**IP VIETNAM**) to refuse registration of the applied-for mark.

Category	Details
Applied-for trademark	CHATEAU LATOUR
Class & goods	33 (wine)
Application No.	4-2013-00415
Applicant	Intrixapple Co., Ltd.
Genuine trademark owner	SOCIÉTÉ CIVILE DU VIGNOBLE DE CHÂTEAU-LATOUR
Action	Filing a Notice of Opposition
Legal ground	Article 74.2(g) of Vietnam’s IP Law (i.e., <i>confusingly similar to a <a href="#">widely used and recognized trademark of others</a></i> ).
Initial ruling	After a thorough review of the evidence and arguments presented during the opposition, IP VIETNAM decided to refuse the trademark registration, citing Article 74.2(e) with a reference to the mark under IR. 770948 and Article 74.2(g) related to the opposition.
Appeal	The trademark applicant contested IP VIETNAM’s refusal decision
Final decision	However, upon review, IP VIETNAM maintained its initial stance and confirmed the refusal in the Decision on settlement of the appeal.



#### Case 2: emz-usa v. (emz-usa, device)

[Executive summary]: Mr. Tran Vick Hung Vuong, located at 2651 N. Harwood St., Suite 370, Dallas, Texas 75201, USA, successfully registered the trademark “emz-usa, device” under Registration No. 172149 with IP VIETNAM. However, BFR Health International, Inc., a U.S.-based corporation, contends that this trademark is rightfully theirs and alleges that Mr. Tran registered the mark with malicious intent. Consequently, BFR Health International has initiated an invalidation proceeding against Trademark Registration No. 172149 at IP VIETNAM, seeking to annul the registration based on [claims of bad faith](#).

Category	Details
Applied-for trademark	emz-usa, device
Class & goods	01 (Microbial fertilizer in granular form, liquid form, powder form)
Application/Registration No.	4-2010-14437 (172149)
Applicant	Tran Vick Hung Vuong
Genuine trademark owner	BFR Health International, Inc.
Action	Filing a trademark invalidation request
Legal ground	Article 96 (i.e., the applicant is not entitled to trademark registration)
Ruling	In 2017, following a careful examination of the evidence and arguments put forth in the invalidation proceedings, IP VIETNAM rendered a

	<p>Decision to invalidate Trademark Registration No. 172149. This decision was made based on substantial proof provided by BFR Health International, Inc, including:</p> <ul style="list-style-type: none"> <li>(i) A Memorandum of Understanding (MOU) jointly executed by BFR Health International, Inc., Mr. Tran Vick Hung Vuong, and two other parties, demonstrating a prior agreement involving the disputed trademark.</li> <li>(ii) A series of email exchanges between BFR Health International, Inc. and Mr. Tran Vick Hung Vuong, which detailed discussions regarding the "emz-usa, device" trademark.</li> <li>(iii) Clear demonstration that BFR Health International, Inc. is the rightful owner of the "emz-usa, device" mark, and allegations that Mr. Tran Vick Hung Vuong filed for the trademark registration in bad faith.</li> </ul>
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### Case 3: MAINETTI v. MAINETTI


*[Executive summary]:* Công ty TNHH Suntex, a Vietnamese enterprise, successfully secured the trademark "MAINETTI" under Registration No. 123570 with IP VIETNAM. Upon discovering this registration, Mainetti (UK) Limited, Scotland-based company that specializes in the manufacturing and distribution of high-quality clothing accessories, including hangers, bags, garment covers, and more, initiated a trademark invalidation proceeding against Trademark Registration No. 123570. The challenge presented by Mainetti (UK) Limited rests on substantial grounds, asserting that the trademark registered by Suntex bears a confusing similarity to its own trademark and trade name "MAINETTI", which has been extensively used prior to the registration date of Suntex's trademark.

Category	Details
Applied-for trademark	<b>MAINETTI</b> (MAINETTI)
Class & goods	20 ( <i>Hanger; hat hanger; clothes hanger; curtain hooks; sock hangers; umbrella stands (all non-metal)</i> ) 35 ( <i>Trading in all kinds of coat hangers, hat hangers, clothes hangers, curtain hangers, sock hangers, umbrella hangers; advertisement; organize exhibitions for commercial or advertising purposes; import and export; product introduction; auction</i> )
Application/Registration No.	4-2007-26377 (123570)
Applicant	Công ty TNHH Suntex
Genuine trademark owner	Mainetti (UK) Limited
Action	Filing a <a href="#">trademark invalidation request</a>
Legal ground	Article 74.2(g) ( <i>i.e., the registered trademark is confusingly similar to another trademark, which has been extensively utilized prior to the filing date</i> ).
Ruling	<p>The invalidation request was filed by Mainetti (UK) Limited in 2011. The other party defended their mark by claiming they were unaware of the "MAINETTI" trademark owned by the real owner. However, the real owner proved that this claim was false. The case was resolved in 2015 with a decision that favored the genuine owner, leading to the cancellation of the "MAINETTI" trademark under Registration No. 123570.</p> <p>IP VIETNAM'S invalidation Decision was made based on substantial proof provided by Mainetti (UK) Limited, including:</p> <ul style="list-style-type: none"> <li>(i) Mainetti (UK) Limited has created the mark "Mainetti" and used it as a <a href="#">trade name</a> since its inception.</li> </ul>

	<p>(ii) The mark "M MAINENETI" has been extensively used in commerce in various countries worldwide before Suntex's filing date.</p> <p>(iii) "MAINETTI serves as a distinctive trade name for its subsidiary, which has been operational in Vietnam since 2003..</p>
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**Case 4:**  v.  (CAF v. CAF PROFESSIONAL SOUND)


[Executive summary]: Tân Việt Company, a Vietnamese enterprise, successfully secured the trademark "CAF PROFESSIONAL SOUND" under Registration No. 390821 with IP VIETNAM. Upon discovering this registration, Kafu Company, a China-based company, filed an invalidation with IP VIETNAM.

Category	Details
Applied-for trademark	
Class & goods	09 (Audio equipment such as speakers, audio amplifiers, disc players). 35 (Trading, importing and exporting audio equipment such as speakers, sound amplifiers, disc players).
Application/Registration No.	4-2018-28713 (390821)
Applicant	Công ty cổ phần xuất nhập khẩu & đầu tư phát triển Tân Việt ( <b>Tan Viet Company</b> )
Genuine trademark owner	Foshan City Nanhai Kafu Professional Audio Equipment Factory ( <b>Kafu Company</b> )
Action	Filing a trademark invalidation request
Legal grounds	<ul style="list-style-type: none"> <li>▪ Article 87.2 (i.e., Organizations and individuals may register a trademark for goods they distribute or sell even if they do not manufacture these goods themselves, as long as the manufacturer agrees to this arrangement and does not use the mark themselves)</li> <li>▪ Article 87.7 (i.e., preventing representatives or agents from registering trademarks in their own name without the consent of the actual trademark owner, in countries that are parties to treaties that Vietnam has agreed to. An agent or representative can only register a mark under their name if: (i) They have explicit agreement from the original trademark owner, or (ii) There is a justifiable reason for the registration).</li> </ul>
Ruling	<p>After a thorough review of the evidence and arguments presented, IP VIETNAM decided to invalidate Trademark Registration No. 123570, citing Article 87.2 and 87.7 as legal grounds.</p> <p>IP VIETNAM'S invalidation Decision was made based on substantial proof provided by Mainetti (UK) Limited, including:</p> <p>(i) Kafu Company and Tan Viet Company had a commercial relationship since 2016. Tan Viet Company was an exclusive agent of Kafu Company. Documentation attesting to this partnership includes a variety of pivotal records:</p> <ul style="list-style-type: none"> <li>✓ <b>Contract details:</b> The "CAF" sign is prominently displayed on the "box speaker" under Contract No. 01/NK/2016, executed on August 8, 2016.</li> <li>✓ <b>Invoice evidence:</b> The logo of Kafu Company is featured on Invoice number CAF1002, issued on July 29, 2016.</li> <li>✓ <b>Distributorship:</b> An Exclusive Distributor Certificate validates the exclusive rights granted to the partnership, spanning from 2016 to 2019.</li> </ul>

	(ii) No written authorization of Kafu Company for Tan Viet Company to apply for registration of the trademark "CAF PROFESSIONAL SOUND, fig" for products and services in class 09 and 35 in Vietnam. Kafu Company has never agreed to let Tan Viet Company register the CAF trademark in Viet Nam.
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## Case 5: v.

*[Executive summary]:* Cao Thanh Hai, a Vietnamese natural person, applied to register the mark "EVELINE COSMETICS, Device" for the goods in Class 03 (cosmetics). Przedsiębiorstwo Produkcyjno-Handlowe "EVELINE COSMETICS", a Polish company which engages in manufacturing a wide range of makeup, facial and body care products, founded in 1983, the company's products are now available in more than 70 countries around the world. Upon identifying the potential infringement represented by the trademark application, Eveline Cosmetics engaged KENFOX IP & Law Office to execute a Notice of Opposition against the registration, safeguarding its esteemed brand and its international market presence.

Category	Details
Applied-for trademark	
Class & goods	03 (cosmetic)
Application No.	4-2010-22897
Applicant	Cao Thanh Hai
Genuine trademark owner	Przedsiębiorstwo Produkcyjno-Handlowe "EVELINE COSMETICS"
Action	Filing a Notice of Opposition
Legal ground	Article 74.2(g) of Vietnam's IP Law (i.e., confusingly similar to a widely used and recognized trademark of others)
Initial ruling	After a thorough review of the evidence and arguments presented during the opposition proceedings, IP VIETNAM rendered a decision to refuse the trademark registration. The refusal was grounded on Article 74.2(g) of the legal ground which served as the basis for rejecting the application.

### Final thoughts

Even if a third party has filed for registration of the trademark in advance, the door to regaining trademark rights is not closed. However, there is no guaranteed path to victory. [Trademark squatters in Vietnam](#) are becoming increasingly professional and are employing very sophisticated tactics. As a result, replicating the victories achieved in past cases will not be straightforward, and the battle against trademark squatting is expected to become increasingly fierce.

Contact KENFOX IP & Law Office in case you require our professional advice on bad faith trademark issues in Vietnam.

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